

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

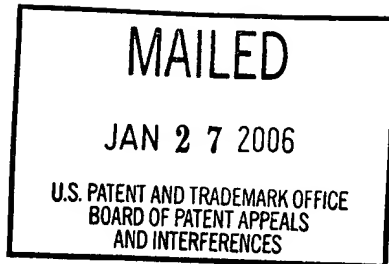
UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte DENNIS W. NUSSER



---

Appeal No. 2005-2467  
Application No. 08/612,969

---

ON BRIEF

---

Before FRANKFORT, CRAWFORD, and BAHR, Administrative Patent Judges.  
FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is being remanded to the examiner under the authority of 37 CFR § 41.50(a) and MPEP § 1211 for action in accordance with the following comments.<sup>1</sup>

On March 4, 2003 appellant filed a Notice of Appeal from the examiner's final rejection of claims 1-6, 9-19, 21-25, 27 and 28. On July 25, 2003 appellant filed an Appeal Brief. That paper

---

<sup>1</sup>In light of this remand, the oral hearing scheduled for January 24, 2006, has been VACATED. Appellant's representative was notified of this fact by Mr. Craig Feinberg, Programs and Resources Administrator for the Board of Patent Appeals and Interferences, in a telephone call on January 18, 2006.

Appeal No. 2005-2467  
Application No. 08/612,969

included (at pages 15-16) an argument based on "Secondary considerations" and discussed evidence received by appellant subsequent to the filing of the Notice of Appeal and which appellant seeks consideration of "as evidence of recognition by those in the industry of the long-felt need for Appellant's invention." However, appellant failed to attach a copy of the above-noted evidence to the brief. Therefore, on August 4, 2003 appellant filed a "Substitute Appeal Brief," adding a second Appendix containing the evidence "inadvertently omitted from the original Appeal Brief filed on July 25, 2003" and correcting several typographical errors in the original brief.

An Examiner's Answer was mailed on November 5, 2003. The answer, on page 1, is said to be responsive to "the appeal brief filed July 25, 2003." No mention is made by the examiner of the "Substitute Appeal Brief" filed August 4, 2003, appellant's argument relying on secondary considerations, or the evidence attached to the Substitute Brief as Appendix II.

On January 5, 2004 appellant filed a Reply Brief, noting on page 2 thereof the filing of the Substitute Brief and the inclusion in Appendix II of the evidence relating to long-felt

Appeal No. 2005-2467  
Application No. 08/612,969

need. On page 7 of the Reply Brief appellant again presents the argument regarding secondary considerations and discusses the evidence thereof attached as Appendix II. Appellant also specifically notes that "[t]hese secondary considerations were not alluded to in the Examiner's Answer."

On March 31, 2004 the examiner mailed a communication indicating only that the reply brief filed January 5, 2004 "has been entered and considered" and that the application was being forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

Our problem is that the record is unclear as to the entry or non-entry of the Substitute Brief filed August 4, 2003 and the evidence attached thereto as Appendix II. While the examiner has purportedly "entered and considered," the reply brief, he has apparently ignored appellant's comments regarding the Substitute Brief and the arguments and evidence of "long-felt need" contained therein. Accordingly, we REMAND for a response on the record from the examiner as to the status of the Substitute Brief and the evidence of "long-felt need" and its impact on the examiner's rejections.

Appeal No. 2005-2467  
Application No. 08/612,969

If the Substitute Brief and evidence are entered, the examiner should issue a supplemental examiner's answer responsive to appellant's points of argument in the Substitute Brief and specifically address the new evidence.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

## REMANDED

Charles E. Frankfort

CHARLES E. FRANKFORT  
Administrative Patent Judge

MURRIEL E. CRAWFORD  
Administrative Patent Judge

  
JENNIFER D. BAHR

JENNIFER D. BAHR  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES

Appeal No. 2005-2467  
Application No. 08/612,969

CHARLES W. CALKINS  
KILPATRICK STOCKTON L.L.P.  
1001 WEST FOURTH STREET  
WINSTON SALEM, NC 27101

CEF/jrg